

Remarks

The instant Office Action dated August 13, 2009, presents the following new grounds of rejection: claims 1-5 and 9-17 stand rejected under 35 U.S.C. § 103(a) over Sanford (U.S. Patent No. 6,424,300) in view of Rousu (U.S. Patent Pub. 2003/0114188); and claims 8 and 20 stand rejected under 35 U.S.C. § 103(a) over the ‘300 and ‘188 references in view of Schamberger (U.S. Patent Pub. 2003/0117331). Applicant traverses the rejection in the following discussion and without acquiescing to any objection, rationale or averment made in the Office Action.

Applicant appreciates that the Examiner has indicated claims 6-7 and 18-19 as being objected to and allowable if rewritten in independent form. However, Applicant submits that amendment to this end is unnecessary as the rejections of the underlying claims are improper.

Applicant respectfully traverses each of the § 103(a) rejections over the ‘300 and ‘188 references because the asserted teachings lack correspondence to the claimed invention and proper motivation. For example, neither of the asserted references teaches the claimed invention “as a whole” (§ 103(a)) including, e.g., aspects regarding substrate-mounted RF components and/or such RF components characterised in that a notch antenna is provided in the substrate for receiving signals, and de-activating circuitry is provided for de-activating the notch antenna when the PIFA is being used for transmitting signals. The Office Action acknowledges that the ‘300 reference does not teach claimed aspects directed to the de-activating circuitry in any form. The Office Action relies on apparently alternative embodiments from teaching in the ‘188 reference for this deficiency, but fails to recognize: that the asserted de-activating circuits identified in the ‘188 reference are not mounted on a substrate as claimed; that the ‘300 reference expressly teaches that its PCB-based embodiments are intended to eliminate the need for including additional antenna-related components (*see, e.g., Abstract and Summary Col.4:21-22 and Col.4:63-64, and generally the Detailed Description*); and that the PCB-based embodiments in the ‘300 reference do not provide for inclusion of the asserted de-activating circuits identified in the ‘188 reference.

For the rejection to be maintained, proper showings are needed for each requirement of correspondence, likelihood and motivation. For the present rejections, none of these

requirements are satisfied. With respect to the requirement of correspondence, because neither the ‘300 nor ‘188 reference teaches aspects of the claimed invention directed to substrate-mounted de-activation circuits as claimed, no reasonable interpretation of the asserted prior art, taken alone or in combination, can provide correspondence. Accordingly, each of the § 103(a) rejections fails for lack of correspondence and Applicant requests that it be withdrawn.

With respect to the requirements of likelihood and motivation, because neither the ‘300 nor ‘188 reference teaches aspects of the claimed invention and/or because a skilled artisan would not attempt to add antenna-related components in light of the ‘300 reference’s express purpose to eliminate additional antenna-related components, no reasonable interpretation of the asserted prior art, taken alone or in combination under § 103, can be considered a likely combination to be implemented by a skilled artisan. In this regard, the cited references expressly teach away from the Office Action’s proposed combination. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main (‘300) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) (“[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.”). Applicant further submits that the combination would render the invention inoperable because the asserted embodiment of the ‘300 reference does not structurally or functionally permit for the asserted modifications. Under M.P.E.P. § 2143.01, the rejections cannot be maintained. For further discussion of these motivation requirements, the Examiner is referred to the remarks presented by Applicant in the underlying Office Action Response.

In view of the above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062 (or the undersigned).

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